



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/919,843	08/02/2001	Yoshihiko Obata	1506-1010	5667

21171 7590 08/10/2007  
STAAS & HALSEY LLP  
SUITE 700  
1201 NEW YORK AVENUE, N.W.  
WASHINGTON, DC 20005

EXAMINER
----------

VAN BRAMER, JOHN W

ART UNIT	PAPER NUMBER
----------	--------------

3622

MAIL DATE	DELIVERY MODE
-----------	---------------

08/10/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/919,843	<b>Applicant(s)</b> OBATA, YOSHIHIKO	
	<b>Examiner</b> John Van Bramer	<b>Art Unit</b> 3622	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**


***Response to Amendment***

1. The amendment filed May 17, 2007 cancelled no claims. Claims 1, 7, and 8 were amended and new claims 13 was added. Therefore, the currently pending claims are Claims 1 – 8, and 13.

***Claim Rejections - 35 USC § 112***

2. The amendment filed on May 17, 2007 has the second paragraph of 35 U.S.C. 112 deficiencies raised in the Office Action dated December 1, 2006. Therefore, the examiner hereby withdraws the rejection.

***Claim Objections***

- 
3. Claims ~~X~~ 7, and 8 are objected to because of the following informalities. Claims ~~X~~ 7, and 8 have been amended, however the status identifier for each of these claims indicates that the claims have been previously presented. The applicant is reminded that new amendments to the claims should be presented with the status identifier of "currently amended". Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be

Art Unit: 3622

patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-4, and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al. (U.S. Patent Number: 6,694,355) in view of Walker et al. (U.S. Patent Number: 6,616,458).

Claims 1 and 4: Behar discloses a profit sharing method used for designing a product having a plurality of elements modifiable to adapt to fashion trends, the method being executed by a server computer and comprising:

- a. Providing participants with a questionnaire including a plurality of questions, each question concerning an element of the product, asking each participant to select one option from a plurality of options for the element of the product in each question. (Col 5, lines 36 – 56, and Fig. 3) (A questionnaire is not limited to text based representation. The outline Fig. 3, 302 shown a number of sections from which a user decides the type of part to use in each section. Therefore, each section represents a multiple-choice question. Since each section has multiple possible parts that can be selected, these parts represent possible answers to each multiple-choice question. Hence, Behar is providing participants with a questionnaire, with a plurality of questions and each question has a multiplicity of answers.)
- b. Retrieving answers to the questionnaire including pieces of answer information each specifying the one option for each question selected by a

participant from the plurality of options corresponding to the element in each question. (Col 6, lines 12 – 41)

- c. Specifying one adopted option from the plurality of options of each question of the questionnaire corresponding to the element, based on the retrieved pieces of answer information (Col 6, lines 29 – 41).
- d. Determining a final design of the product in which each element is as specified in the corresponding one adopted option. (Col 6, lines 29 – 41)
- e. Assigning predetermined points corresponding to a weight value of the element for each question to each participant who has selected the corresponding one adopted option from the plurality of options of the question (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col 6, lines 29 – 41)
- f. Determining an individual return value, which should be given to the participant in accordance with the predetermined points, assigned to the participant. (The award incentive) (Col 6, lines 29 – 41)

While Behar does not explicitly state that the one adopted option is specified independently of a result of a specification of any other element, the analogous art of Walker discloses selecting adopted options that are independent of other elements within a survey (Col 13, lines 54-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the option presented by each individual question, which generates the most favorable response as the adopted option. One would have been

Art Unit: 3622

motivated to do this in order to develop a product that has the broadest appeal, corresponds to the trends and styles of the time, and therefore maximized potential sales (Col 6, lines 59-64)

While Behar and Walker do not explicitly state that the individual return value (award incentive) that is proportional to the weighted value of the participants contribution is paid based upon the sales achievement, tallied up between a start of selling date and a predetermined date, of the product made according to the final design, Official Notice is taken that providing compensation, to participants that contribute to the development of a new product, based upon the sales achievement of said product is old and well known. Such payments are often referred to as royalties. Individuals that participate in the development of new songs such as songwriters, and singers receive royalties based upon the number of times a song is played. Actors that participate in the creation of a movie or television show are often paid royalties based upon the number of times the show is aired. Inventors that participate in the development of a newly patented idea and then license the invention to another, are often paid royalties based upon the sales of the product. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the participants, which have helped to invent the final product, compensation based upon their contribution as related to the final sales of the invented product. The rational for providing such a payment methodology is that the payment of

royalties based upon product sales is one of a limited number of ways in which participants in the creation of an invention can be compensated.

Claim 3: Bahar, Walker and Crane disclose a method according to claim 1, wherein each piece of answer information specifies, as to a plurality of elements, options which characterize the product, respectively. (Col 5, lines 36 – 56, and Fig. 3)

Claim 6: Bahar, Walker and Crane disclose a method according to claim 1, further comprising a step of creating image data of the product characterized by at least one adopted option (Col 6, lines 49-51).

Claim 7: Bahar discloses a profit sharing method executed by a client computer connectable to a server computer, the method comprising:

- a. Receiving a questionnaire including a plurality of questions, each question being directed to an element characterizing a commercial article. (Col 5, lines 36 – 56, and Fig. 3)
- b. Obtaining pieces of answer information each specifying at least one option selected by a participant from options corresponding to each question (Col 6, lines 12 – 17)
- c. Sending the obtained pieces of answer information to the server computer to determine said server computer to execute (Col 6, lines 13-16).

- d. Specifying one adopted option corresponding to the element, based on the pieces of answer information received from the client computer and determining a final design of the commercial article according to the one adopted option for each of the plurality of questions of the questionnaire. (Col. 6, lines 29-41)
- e. Assigning predetermined points corresponding to a weighted value of the element to a participant who selected said one adopted option as the at least one option. (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col. 6, lines 29-41) wherein for each respective element all of the participants who have selected the adopted option are specified and respectively given points corresponding to a weight value which is predetermined for the element. (Col 6, lines 29 – 41) (The award incentive)
- f. Determining individual return values that should be respectively given to participants in accordance with the predetermined points assigned to the participants. (Col 6, lines 29-41)

While Behar does not explicitly state that the one adopted option is specified independently of a result of a specification of any other element, the analogous art of Walker discloses selecting adopted options that are independent of other elements within a survey (Col 13, lines 54-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the option presented by each individual question, which generates the



most favorable response as the adopted option. One would have been motivated to do this in order to develop a product that has the broadest appeal, corresponds to the trends and styles of the time, and therefore maximized potential sales (Col 6, lines 59-64)

While Behar and Walker do not explicitly state that the individual return value (award incentive) that is proportional to the weighted value of the participants contribution is paid based upon the sales achievement, tallied up between a start of selling date and a predetermined date, of the product made according to the final design, Official Notice is taken that providing compensation, to participants that contribute to the development of a new product, based upon the sales achievement of said product is old and well known. Such payments are often referred to as royalties. Individuals that participate in the development of new songs such as songwriters, and singers receive royalties based upon the number of times a song is played. Actors that participate in the creation of a movie or television show are often paid royalties based upon the number of times the show is aired. Inventors that participate in the development of a newly patented idea and then license the invention to another, are often paid royalties based upon the sales of the product. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the participants, which have helped to invent the final product, compensation based upon their contribution as related to the final sales of the invented product. The rationale for providing such a payment methodology is that the payment of

royalties based upon product sales is one of a limited number of ways in which participants in the creation of an invention can be compensated.

Claim 8: Bahar discloses a computer readable medium containing a profit sharing program comprising:

- a. A module making a server computer to issue a questionnaire including a plurality of questions, each question being directed to an element characterizing a commercial article, and having a plurality of options as possible answers to the question. (Col 5, lines 36 – 56, and Fig. 3)
- b. A module making the server computer to acquire pieces of answer information, each piece of information specifying at least an option selected for a question by a participant. (Col 6, lines 29-32 and lines 13-16).
- c. A module making the server computer to select for each question one option corresponding to the element, based on the acquired pieces of answer information and the determine a final design of the commercial article according to the adopted option for each element. (Col 6, lines 29-36)
- d. A module making the server computer to assign for each question predetermined points to a participant who selected the adopted option. (The measure of each degree of variance between the final design and the pre-determined design scheme) (Col. 6, lines 32-35) wherein for each respective element, all of the participants who have selected the adopted option on the

questionnaire are specified and respectively given points corresponding to a weight value which is predetermined for the element. (Col 6, lines 29 – 41)  
(The award incentive)

- e. A module making the server computer to determine individual return values that should be respectively given to participants in accordance with the predetermined points assigned to the participants. (Col 6, lines 29-33)

While Behar does not explicitly state that the one adopted option is specified independently of a result of a specification of any other element, the analogous art of Walker discloses selecting adopted options that are independent of other elements within a survey (Col 13, lines 54-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to select the option presented by each individual question, which generates the most favorable response as the adopted option. One would have been motivated to do this in order to develop a product that has the broadest appeal, corresponds to the trends and styles of the time, and therefore maximized potential sales (Col 6, lines 59-64)

While Behar and Walker do not explicitly state that the individual return value (award incentive) that is proportional to the weighted value of the participants contribution is paid based upon the sales achievement, tallied up between a start of selling date and a predetermined date, of the product made according to the final design, Official Notice is taken that providing compensation, to participants that contribute to the development of a new product, based upon the sales

achievement of said product is old and well known. Such payments are often referred to as royalties. Individuals that participate in the development of new songs such as songwriters, and singers receive royalties based upon the number of times a song is played. Actors that participate in the creation of a movie or television show are often paid royalties based upon the number of times the show is aired. Inventors that participate in the development of a newly patented idea and then license the invention to another, are often paid royalties based upon the sales of the product. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the participants, which have helped to invent the final product, compensation based upon their contribution as related to the final sales of the invented product. The rationale for providing such a payment methodology is that the payment of royalties based upon product sales is one of a limited number of ways in which participants in the creation of an invention can be compensated.

6. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al. (U.S. Patent Number: 6,694,355).

Claim 13: Bahar discloses a profit sharing method for determining a design of a product having a plurality of elements, based on preferred embodiments of each element of the product input by participants using multiple choice questions via network connected terminals, comprising:

- a. Determining a final design of the product in which each element is executed according to an embodiment selected by most participants. (Col 6, lines 12-41)
- b. Manufacturing the product according to the final design and rewarding each participant. (Col 6, lines 12-41)

While Behar and Walker do not explicitly state that the individual return value (award incentive) that is proportional to the weighted value of the participants contribution is paid based upon the sales achievement, tallied up between a start of selling date and a predetermined date, of the product made according to the final design, Official Notice is taken that providing compensation, to participants that contribute to the development of a new product or idea, based upon the sales achievement of said product is old and well known. Such payments are often referred to as royalties. Individuals that participate in the development of new songs such as songwriters, and singers receive royalties based upon the number of times a song is played. Actors that participate in the creation of a movie or television show are often paid royalties based upon the number of times the show is aired. Inventors that participate in the development of a newly patented idea and then license the invention to another, are often paid royalties based upon the sales of the product. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the participants, which have helped to invent the final product, compensation based upon their contribution as related to the final sales of the invented product. The

rational for providing such a payment methodology is that the payment of royalties based upon product sales is one of a limited number of ways in which participants in the creation of an invention can be compensated.

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al. (U.S. Patent Number: 6,694,355) in view of Walker et al. (U.S. Patent Number: 6,616,458) in further view of Murphy (MM, MM ... BLUE! PUBLIC OBVIOUSLY WAS READY FOR A CHANGE IN M&M COLORS: [CITY Edition] Marli Murphy KANSAS CITY STAR. Dayton Daily News. Dayton Ohio: Aut 19, 1995. pg. 3.C).

Claim 2: Bahar and Walker disclose the method according to claim 1, but is silent with regard to the specific method in which the adopted option is elected. However, the analogous teachings of Murphy disclose a manufactured commercial article in which participants determined the design of a product enhancement based upon the option selected by most participants. Therefore, choosing the adopted option as the one identified as most desirable from participants would have been obvious to one of ordinary skill in the art at the time of the application. One would have been motivated to do this in order to allow the manufacture to design a product that will maximize potential sales based upon identified user trends. In fact, Bahar mentions (Col 6, lines59-63) that such identification would benefit the manufacturer.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar et al. (U.S. Patent Number: 6,694,355) in view of Walker et al. (U.S. Patent Number: 6,616,458) in further view of West et al. (U.S. Patent Number: 6,175,833).

Claim 5: Bahar, and Walker disclose a method according to claim 1, but is silent regarding transmitting the final results of the questionnaire to the participant.

However, the analogous teachings of West disclose providing participants in a survey with the results of the survey (Col 9 lines 37-43). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate sending participant in the questionnaire of Bahar the final results of the survey. One would have been motivated to do this in order to allow participants to see how their opinions have affected the final design of the product and to encourage them to continue to participate in the future.

### ***Response to Arguments***

9. Applicant's arguments filed May 17, 2007 are directed towards the newly added amendments to Claims 1, 7 and 8. As such, the amendments have been addressed in the 35 U.S.C. 103(a) rejection of instant Office Action. The arguments have been considered but are moot in view of the new ground(s) of rejection necessitated by amendments to the claims.

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JVB/  
jvb



**ERIC W. STAMBER**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 3600**